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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/645,847	08/22/2003	William E. Klunk	076333-0323	8143

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EXAMINER

JONES, DAMERON LEVEST

ART UNIT	PAPER NUMBER
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1618

DATE MAILED: 01/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/645,847	KLUNK ET AL.	
	Examiner	Art Unit	
	D. L. Jones	1618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10/30/05; 2/3/05; & 4/20/04.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) 4-7, 11-13 and 15-27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 8-10 and 14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2/3/05 & 4/20/04</u> . | 6) <input type="checkbox"/> Other: _____ |

APPLICANT'S INVENTION

1. Applicant's invention is directed to benzothiazole derivatives and uses thereof.

Note: Claims 1-27 are pending.

RESPONSE TO APPLICANT'S ELECTIONS

2. Applicant's election of Group I, claims 1-14 in the reply filed on 10/31/05 is acknowledged. In addition, Applicant elected the species of Example 4, page 22, in the specification. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). Thus, the restriction requirement is deemed proper and is made FINAL.

Notes: (1) Initially, Applicant's elected species was searched. However, since no prior art was found which could be used against the claims, (2) the search was expanded to the compound of Formula I wherein R1 is OH; R2 is hydrogen; R3 is hydrogen; and R4 is $^{11}\text{CH}_3$. (3) The search was not further expanded because prior art was found which could be used to reject the claims. (4) Claims 1, 8-10, and 14 are directed to the elected species. (5) Claims 1-3 and 14 are directed to the species wherein R1 is OH; R2 is hydrogen; and one of R3 or R4 is hydrogen and the other is $^{11}\text{CH}_3$.

WITHDRAWN CLAIMS

3. Claims 4-7, 11-13, and 15-27 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention/species.

DOUBLE PATENTING REJECTIONS

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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5. Claims 1-3, 8-10, and 14 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 24 of copending Application No. 10/388,173. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are directed to compounds that have radiolabeled atoms (see Applicant's elected species and the elected species). The claims differ in that those of the instant invention specify where the radiolabeled atom is while those of 10/388,173 do not give a specific location for the radiolabeled atom, but state that the compounds (see compounds 7 and 39) contain at least one radiolabeled atom.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

103 REJECTIONS

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-3 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mathis et al (J. Med. Chem., May 24, 2003, Vol. 46, No.13, pages 2740-2754).

Mathis et al disclose the synthesis and evaluation of ¹¹C-labeled 6-substituted 2-arylbenzothiazoles as amyloid imaging agents (see entire document, especially, abstract). In particular, Mathis et al disclose Compound 19 on page 2742 which

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encompasses Applicant's compound when R1 is OH; R2 is hydrogen; and one of R3 or R4 is hydrogen and the other R4 is $^{11}\text{CH}_3$. Thus, both Applicant and Mathis et al disclose overlapping compounds.

COMMENTS/NOTES


8. Claims 1, 8-10, and 14 are allowable over the elected species only; however, Applicant MUST address and overcome the double patenting rejection above. In particular, the claims are distinguished over the prior art of record because the prior art neither anticipates nor renders obvious a compound having the limitations of the elected species.

9. Applicant is respectfully requested to supply the year of publication of the following references which are listed on the information disclosure statement filed 4/20/04: (1) Deardorff; (2) Avis; and (3) Balant et al in the next correspondence to the Examiner.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. L. Jones whose telephone number is (571) 272-0617. The examiner can normally be reached on Mon.-Fri., 6:45 a.m. - 3:15 p.m..
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Hartley can be reached on (571) 272-0616. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



D. L. Jones
Primary Examiner
Art Unit 1618

January 23, 2006